

REMARKS

Claims 1-5, 7- 8, 10-24 and 26 remain in the present application. Claims 2, 3, 5, 10, 11, 13, 17, 19, 21, 22 and 24 are withdrawn subject to a restriction requirement. Claims 1, 8 and 20 have been amended herein. Claims 6, 9 and 25 have been canceled herein. Claims 27-32 have been added herein. Thus, claims 1-5, 7-8, 10-24 and 26-32 are pending in this response.

Support for the amendment to independent claims 1 and 20 can be found in at least originally filed dependent claims 6 and 25. Support for the amendment to independent claim 8 can be found in at least originally filed dependent claim 9. Support for newly added independent claims 27 and 30 can be found in at least lines 4-20 of page seven of the specification as filed.

Reconsideration of the application is respectfully requested in view of the following responsive remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

In the Office Action of May 16, 2005, the following actions were taken:

(1) Claims 1, 4, 7, 8, 12, 15, 16, 20, 23 and 26 were rejected under 35 U.S.C. § 102(a) and 35 U.S.C. § 102(e) as being anticipated by Lee (U.S. 20030025321 A1).

(2) Claims 6, 9, 14, 18 and 25 were rejected under 35 U.S.C. § 103(a) as being obvious over Lee in view of Smith (EP 0884195 A1).

It is respectfully submitted that the presently pending claims be examined and allowed.

Rejections under 35 U.S.C. § 102

Claims 1, 4, 7, 8, 12, 15, 16, 20, 23 and 26 (including independent claims 1, 8 and 20) were rejected under 35 U.S.C. § 102(a) and 35 U.S.C. § 102(e) as being anticipated by Lee.

Independent claims 1, 8 and 20 have been amended to incorporate the subject matter of originally filed dependent claims 6, 9 and 25, respectively. As such, each and every element of amended independent claims 1, 8 and 20 is not present in Lee.

Accordingly, the rejections under 35 U.S.C. § 102 have been rendered moot and Applicant respectfully requests that they be withdrawn.

Rejections under 35 U.S.C. § 103

Claims 6, 9, 14, 18 and 25 were rejected under 35 U.S.C. § 103(a) as being obvious over Lee in view of Smith.

The subject matter of dependent claims 6, 9 and 25 has been incorporated into independent claims 1, 8 and 20, respectively. Claims 6, 9 and 25 have been canceled. Before discussing the rejections under 35 U.S.C. 103, it is thought proper to briefly state what is required to sustain such a rejection.

It is well settled that “[a] claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). The issue under § 103 is whether the PTO has stated a case of *prima facie* obviousness. According to the MPEP § 2142, the Examiner has the burden and must establish a case of *prima facie* obviousness by showing some motivation in a prior art reference to modify that reference, or combine that reference with multiple references, to teach all the claim limitations in the instant application. Applicant respectfully asserts the Examiner has not satisfied the requirement for establishing a case of *prima facie* obviousness in this rejection.

Claims 1 and 20:

Claims 1 and 20 each include the limitation of storing printing information on data storage device (or a data storage device with printing information stored thereon), said printing information comprising data relating to properties of the print medium (emphasis added).

It was held in the Office Action that claims 6 and 25 (which have been incorporated into their respective independent claims 1 and 20) were unpatentable over Lee in view of Smith because, while Lee did not disclose “providing information indicative of properties of a print medium,” Smith did disclose such a limitation, and that it would have been obvious to one having ordinary skill in the art to modify Lee to store information related to the media type in the Lee data storage device.

Applicant respectfully submits, however, that the Smith and Lee references were improperly combined in the Office Action, as neither Lee nor Smith contains motivation to modify the references, or to combine the references with one another, to teach all the claim limitations of claims 1 and 20. Lee discusses storing information on a magnetic layer that allows a recipient of a document with which the magnetic layer is associated to verify whether the document is authentic. No teaching or suggestion is made in Lee about information relating to the print media being used. Conversely, the Smith reference teaches storing information relating to the media type being used by markings that are not magnetic in nature, e.g. bar codes or the like. As a result, it is only by hindsight that one skilled in the art could make the combination asserted by the Examiner, which is impermissible. Further, by combining Smith and Lee, one would end up with print media which includes both a magnetic layer with information relating to authentication (not to print media type), and a bar code that contains information related to print media type. This is not the claimed invention.

For at least this reason, Applicant asserts that the requirement for establishing a case of *prima facie* obviousness in this rejection was not met in the Office Action with respect to amended claims 1 and 20.

Claim 8:

Claim 8 includes the limitations of a printing system that includes “a printing information processor associated with the printer, said printing information processor comprising a data read/write processor capable of both reading data from and writing data to the data storage device” (emphasis added). Even if it were proper to combine Lee and Smith to formulate a rejection of claim 8 (which Applicant expressly refutes), Lee does not discuss specific printing systems utilized in reading or writing to the Lee printing media. Smith discloses, in FIG. 1 and the accompanying written description, a printing system that includes a printhead 12 and a separate sensor 34 that reads coded indicia 32 as it passes thereover. Thus, neither Lee nor Smith discloses a printing system with a read/write processor capable of both reading data from and writing data to a data storage device. As such, withdrawal of this rejection is respectfully requested.

New Claims 27 and 30:

Newly added Claims 27 and 30 each include the limitation of storing printing information on a data storage device (or the limitation of a data storage device having printing information stored thereon), the printing information “comprising data related to content of the printed image” (emphasis added).

Even if it were proper to combine Lee and Smith to formulate a rejection of claims 27 and 30 (which applicant expressly refutes), the coded indicia of the Smith reference includes only information relating to the media type being used. The information contained on the magnetic layer of the Lee reference includes only information allowing a recipient of the document to verify whether the document is authentic by determining if the magnetic image 12 is present, or if the magnetic image 12 is the correct image.

Thus, neither of these references teaches or suggests printing information related to content of the printed image on a data storage device. As discussed in the present specification, page 7, lines 4-20, the present invention allows an operator to determine from the data stored on the data storage device information about the content of the printed image, such as the names of people or objects in the image, locations of people or objects in the image, font types, authorship information, etc. None of these types of information is taught or suggested by Lee or Smith.

In view of the foregoing, it is Applicant's position that independent claims 1, 8, 20, 27 and 30 present allowable subject matter and allowance thereof is respectfully requested. In addition, as claims 4, 7, 12, 14-16, 18, 23, 26, 28-29 and 31-32 each depend from an allowable independent claim, they are also in allowable condition.

If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone W. Bradley Haymond (Registration No. 35,186) at (541) 715-0159 so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any
overpayment to Deposit Account No. 08-2025

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Respectfully submitted,



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